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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,810	01/10/2001	Jochen Voss	Mo-6029/LeA 34,199	7359

7590

04/19/2004

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EXAMINER

BISSETT, MELANIE D

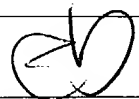
ART UNIT

PAPER NUMBER

1711

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/757,810	Applicant(s) VOSS, JOCHEN	
	Examiner Melanie D. Bissett	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The rejections set forth in the non-final Office action dated 10/23/03 have been maintained.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wolf et al. in view of Lane et al., as evidenced by Univar.

4. From a prior Office action:

Wolf discloses a primer used for the metallization of a substrate. It teaches the substrates that may be used (col. 5 lines 1-3), which include inorganic glasses, metals, and plastics. Plastic substrates include ABS, polycarbonate, polyamides, polyesters, polyethylene, and polypropylene (col. 5 lines 1-13). One primer composition claimed involves a primer consisting of a film former of polyurethane (claim 2). Wolf discloses a primer comprising all of the elements in the applicant's claims 1 and 3, with the exception of a hydrophilic swelling agent (claim 1).

Lane shows a catalytic metal-polymer complex capable of facilitating the electroless metallization of a substrate, further teaching that an anticaking agent may be included in the composition (col. 5 lines 46-49). The laminate formed in the invention is deposited with a metal, rendering the inventive composition layer a base layer for metal (abstract). The compositions of Lane include a metal salt, synthetic monomers or polymers, a solvent, and a crosslinking agent (col. 3 line 66-col. 4 lines 31). Lane includes an anticaking agent like CABOSIL to facilitate the grinding of the metal salts (col. 5 lines 44-55), where the metal salts include halides and acetates of palladium (col. 6 lines 4-32). Wolf intends the use of similar metal salt complexes in the invention (Wolf, col. 3 line 66-col. 4 line 22). It is the examiner's position that it would have been prima facie obvious to form the complex materials of Wolf's invention after grinding with a CABOSIL anticaking compound to facilitate the complexing reaction. An anticaking compound would preserve the large reactive surface areas of the ground metal salt particles by preventing the particles from agglomerating.

It is the examiner's position that the use of such a CABOSIL compound would anticipate the applicant's claimed hydrophilic swelling material, since the claimed properties are inherent to the material. Note that the applicant's specification points to CABOSIL materials as fitting the requirements for the swelling material, including specific surface area and diameter (p. 6 line 25-p. 7 line 13). CABOSIL is "an extremely finely divided silicon dioxide prepared by a special high-temperature hydrolysis process." Also, Univar confirms that untreated CABOSIL materials contain many surface silanol groups, which interact with

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other molecules (p. 9, col. 2). The surface area cited in Univar falls within the applicant's claimed range (p. 15, col. 2). The combination cited above would teach a primer composition comprising a CABOSIL material with the metal salt. Since CABOSIL materials are used in both the cited reference and the applicant's claimed invention, and because the materials are shown to have the applicant's claimed properties, it is the examiner's position that the material would inherently function as the claimed swelling material and would inherently possess the applicant's claimed spherical shape.

Response to Arguments

5. In response to the applicant's arguments that there is no motivation for including CABOSIL materials in the metal salts of Wolf, the examiner has pointed to the Lane teachings that CABOSIL materials provide anticaking properties during the grinding of metal salts. Lane provides no indication for removing the anticaking agents from the metal salt mixture and does not indicate any detrimental effects of leaving the anticaking agent in the grinding mixture. Rather, the reference indicates that processing aids may be present in the composition (at least example 1). Thus, it is the examiner's position to interpret that the processing aids would be incorporated into the final product.

6. Regarding the applicant's arguments that Wolf does not teach the use of anticaking agents, it is noted that the secondary reference, Lane, has provided the teaching for the use of such materials. One of ordinary skill in the art would recognize the benefits of using an anticaking agent while grinding metal salts of Lane or Wolf.

7. In response to the applicant's arguments that Wolf disclaims the use of a swelling adhesion treatment, it is maintained that this does not exclude the use of a swelling agent in the primer composition. Rather, Wolf prefers not to swell the plastic *substrate* while adhering the primer and metallic layers. See Reichert et al., col. 1, defining swelling adhesion as a treatment of the substrate but not of the primer composition.

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8. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

9. Regarding the applicant's arguments that many assumptions must be made in order to combine the references, it is first noted that Lane teaches use of CABOSIL as an anticaking agent for the same metal salts used by Wolf. One of ordinary skill in the art would recognize that grinding metal salts with CABOSIL would be beneficial, based on Lane's teachings. It is again noted that Lane does not teach removing the anticaking agent from the metal salt compounds. Thus, one of ordinary skill in the art would not look to add purification steps if deemed unnecessary. It is also the examiner's position that one of ordinary would recognize that the anticaking agents would be equally beneficial in the inventions of Lane and Wolf, since the references teach the same metal salt complexes. Regarding the amounts of anticaking agents, Lane teaches a range of anticaking agent content based on the amount of metal salt complex used. Thus, one of ordinary skill in the art would have guidance to the amount of CABOSIL necessary to provide anticaking benefits. The arrival at the applicant's claimed ranges would not require undue experimentation.

10. In response to the applicant's arguments that the CABOSIL materials of the references would not inherently act as a swelling material, the examiner has provided reasoning for such an

inherency argument. The materials are the same types of materials employed by the applicant, the materials have been shown to possess the material properties claimed by the applicant, and the materials are to be included in the same type of mixture as claimed by the applicant. The applicant has not provided evidence that the CABOSIL materials of Lane would not function as a swelling material in the invention of Wolf.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

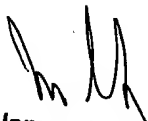
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mdb


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